



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/612,789 | 07/10/2000 | Satyan G. Pitroda | 2683/79382 | 9381 |

7590 02/14/2003

Walter J Kawula Jr Esq
Welsh & Katz Ltd
22nd Floor
120 South Riverside Plaza
Chicago, IL 60606

EXAMINER

TRINH, TAN H

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,789

Applicant(s)

PITRODA, SATYAN G.

Examiner

TAN TRINH

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract is too long, it should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention Heinonen (U.S. Patent No. 5,887,266).

Regarding to claim 1, Heinonen teaches a method of exchanging payment information in an electronic transaction, comprising: a) a first electronic transaction device transferring payment information to a second electronic transaction device; b) the second electronic transaction device transferring value information to the first electronic transaction device;

c) the second electronic transaction device transferring value information and payment information to a service consolidation center (see fig. 6, col. 8 lines 8-37).

Regarding to claims 2-4, Heinonen teaches the value information comprises a virtual card, authorization code and image of a card (see figs. 3 A-C, 6 and 4A-1 item 106 authentication and security), col. 1 lines 38-49, col. 3 lines 28-43).

Regarding to claim 6, Heinonen teaches the payment information comprises cash payment information (see col.3 lines 30-43).

Regarding to claim 7, Heinonen teaches the cash payment information includes an identification of a person providing a cash payment (see col.3, lines 30-43).

Regarding to claim 8, Heinonen teaches the payment information comprises credit payment information (see col.3, lines 30-43).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen (U.S. Patent No. 5,887,266) in view of Despres (U.S. Patent No. 6,434,379).

Regarding to claim 5, Heinonen teaches the value information of smart card (SIM). But Heinonen fails to show a quantity of minutes corresponding to a pre-paid telephone account.

However, Despres teaches a quantity of minutes corresponding to a pre-paid telephone account (see fig. 2 and col. 1 lines 60-67 and col. 2, lines 5-10 and 16-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Heinonen system and the teaching of Despres with quantity of minutes on pre-paid telephone account so that the user can keep track credit in the account easier.

Regarding to claim 9, Heinonen teaches an entering value purchased information and subscriber information in a retailer electronic transaction device and the retailer electronic transaction device transferring the value purchased information and subscriber information to a distributor (see fig. 6 and col. 10 lines 18-67, col. 11 lines 1-3). But Heinonen fails to show retail sales of pre-paid telephone cards to cash subscribers mobile operator.

However, Despres teaches pre-paid telephone cards to cash subscribers, entering value purchased information and subscriber information a mobile operator and adding value corresponding to the value purchased information to an account corresponding to the subscriber information (see figs. 1-3, col. 1 lines 60-67, col. 2 lines 1-47, col. 5, lines 9-67, col. 6 lines 1-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Heinonen system and the teaching of Despres pre-paid telephone

Art Unit: 2684

card technique thereto in order provide a simple billing and easy to keep track the usage of the air time on the account.

Regarding to claim 10, Heinonen teaches the step of entering value purchased information and subscriber information in a retailer electronic transaction device further comprises electronically transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device (see fig. 6 and col. 10 lines 10-67).

Regarding to claim 11, the step of entering value purchased information and subscriber information in a retailer electronic transaction device further comprises manually entering the value purchased information and subscriber information into the retailer electronic transaction device. This is obvious to the electronically transfer, so that the entering value purchased information and subscriber information in a retailer electronic transaction can be flexibility.

6. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tushie (U.S. Patent No. 6,202,155) in view of Heinonen (U.S. Patent No. 5,887,266).

Regarding to claim 12, Tushie teaches a method of distributing virtual pre-paid cards comprising: creating a virtual pre-paid card (see figs. 1-2 and 6A-B, col. 2 lines 51-67 and col. 3 lines 1-31 and lines 55-67, col. 4 lines 1-19). But Tushie fails to show downloading the virtual pre-paid card to a retailer electronic transaction device and transferring the virtual pre-paid card from the retailer electronic transaction device to a MO Subscriber Handset.

Art Unit: 2684

However, Heinonen shows the downloading the virtual pre-paid card to a retailer electronic transaction device and transferring the virtual pre-paid card from the retailer electronic transaction device to a MO subscriber Handset (see fig. 6 and col. 1 lines 38-49, col. Col. 3 lines 29-56, col. 5 lines 39-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Tushie system and the teaching of Heinonen with data transfer on mobile virtual card to and from the retailer technique thereto in order provide the mobile subscriber to use hand set with pre-paid card to make payment and transaction easier.

Regarding to claim 13, Heinonen teaches the step of transferring payment information from the MO subscriber handset to the retailer electronic transaction device (see fig. 6 and col. 10 lines 27-38).

Regarding to claim 14, Tushie teaches the step of creating a virtual card is performed by an electronic transaction device service center (see col. 2 lines 3-31).

Regarding to claim 15, Heinonen teaches the steps of transferring payment information and subscriber information from the MO subscriber handset to the retailer electronic transaction device; and transferring the payment information and subscriber information from the retailer electronic transaction device to the electronic transaction device service center (see fig. 6 and abstract lines 6-14, and col. 8 lines 8-37).

Regarding to claim 16, Heinonen teaches the steps of downloading the virtual card to a retailer electronic transaction device occurs via a MO switch (see col. 8 lines 33-42).

Regarding to claim 17, Tushie teaches the step of creating a virtual card comprises creating a plurality of virtual cards and the step of downloading the virtual card to a retailer electronic transaction device comprises downloading batches of virtual transaction cards to the retailer electronic transaction device (see figs. 1-2 and 6A-B, col. 2 lines 51-67 and col. 3 lines 1-31 and lines 55-67, col. 4 lines 1-19 and col. 2 lines 13-31).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawan (U.S. Patent No. 6,442,532) discloses wireless transaction and information system.

Clitherow (U.S. Patent No. 5,479,494) discloses virtual calling card system.

Teicher (U.S. Patent No. 6,257,486) discloses smart card pin system, card, and reader.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

*Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

Art Unit: 2684

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (703) 305-5622. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter, can be reached at (703) 308-6732.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is (703) 306-0377.

Tan H. Trinh
Art Unit 2684
Jan. 28, 203

Uhafr
2/7/03
TU2684